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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,812	10/29/2003	Douglas Van Thorre	1865.015US1	3012

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
WEIER, ANTHONY J	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/605,812	VAN THORRE, DOUGLAS	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112, 1st paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 3-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the original specification does not appear to provide support fro the terminology "the predominant isotonic materials".

Claim Rejections - 35 USC § 112, 2nd paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "the predominant isotonic materials" lacks antecedent basis. Also in claim 1, it is not clear what the predominance is based on. Volume? Weight?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Acton.

Acton discloses a process wherein corn kernels are steeped, milled, and then placed in an isotonic solution (inherently within a vessel; starch suspension) wherein the germ fraction of the corn floats to the top and is separated from the rest of the corn kernel that inherently falls to the bottom. It should be noted that the starch suspension is recycled from another portion of the process and would inherently contain fermentable sugars including sucrose leached from the corn during the steeping portion of the process (page 1, lines 1-85). It should be further noted that the combination of water and sucrose would eixst as the predominant isotonic materials of the solution, particularly since water is so extensive to the makeup of a solution.

7. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al

Brown et al discloses a process wherein corn kernels are steeped in solution, dry milled, and placed in an isotonic solution within an enclosing vessel, said isotonic solution comprising water and inherently fermentable sugars such as sucrose that originally exist in the corn kernel itself and wherein some of the components of said

isotonic solution have been recycled (see the starch/water line from 21), wherein the germ fraction of the corn floats to and is extract from the top of the vessel and is separated from the rest of the corn kernel that falls to and is extracted from the bottom of the vessel (e.g. page 2 and Figure 1). It should be further noted that it appears that the separation of the germ and other kernel contents occurs continuously (see Figure 1).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acton.

The claims further call for the continuous removal of the germ from above and the continuous removal of the remainder of the oil bearing seed from below the vessel used. However, the concept of providing a continuous process from one this batch or semi-batch is notoriously well known. More specifically, making a process continuous does not add patentability to the claims. See Dow v. Coe, 545 O.G. 905; In re Lincoln et al, 1942 C.D. 386; and In re Korpi, 602 O.G. 672.

If it is shown that Acton does not disclose or inherently include an enclosed vessel for treatment, it should be noted that it is notoriously well known to treat items in an enclosed environment, and it would have been further obvious to have performed the

isotonic treatment in an enclosed vessel to, for example, avoid processing contaminants.

10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al.

The claims further call for the continuous removal of the germ from above and the continuous removal of the remainder of the oil bearing seed from below the vessel used. However, the concept of providing a continuous process from one this batch or semi-batch is notoriously well known. More specifically, making a process continuous does not add patentability to the claims. See Dow v. Coe, 545 O.G. 905; In re Lincoln et al, 1942 C.D. 386; and In re Korpi, 602 O.G. 672.

Response to Arguments

11. Applicant's arguments filed 4/3/06 have been fully considered but they are not persuasive.

Applicant argues that no support has been shown to conclude that the process of the Acton and Brown et al references would provide for fermentable sugar and water as being the predominant isotonic agents as claimed. It should be noted that such limitation is under a new matter rejection above. Nevertheless, certainly water is by far the largest component of the solution and the combination of water teamed with any other ingredient would provide a combination that is predominant among all the isotonic materials present. In addition, because sucrose is in the corn and is soluble, during steeping, it is expected that the corn would swell and result in dissolving of the sugar into solution.

It should be noted that the Double Patenting Rejection has been withdrawn due to the abandonment of the copending application.

All other arguments have been addressed in view of the rejections as set forth above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier
June 6, 2006